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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/057,912  | 01/29/2002  | Yutaka Iyoki         | P21952              | 3713             |
| 7055  | 7590        | 03/20/2006           | EXAMINER            |                  |
| GREENBLUM & BERNSTEIN, P.L.C.<br>1950 ROLAND CLARKE PLACE<br>RESTON, VA 20191 |             |                      | PATEL, CHIRAG R     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2141                |                  |
| DATE MAILED: 03/20/2006   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/057,912             | IYOKI, YUTAKA       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Chirag R. Patel        | 2141                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 17-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

Applicant's arguments with respect to claims 17-35 have been considered but are moot in view of the new ground(s) of rejection. Examiner notes that claims 1-16 have been cancelled by the applicant.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-18, 21-22, 25-26, 28, 30, and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi (US 2002/0040397) in view of Matsuura (US 2001/0021945).

As per claims 17, 21, and 25, and 26, Choi discloses a scanner apparatus configured to scan image data, comprising:

an interface configured to be connected to a terminal apparatus via a network;  
and a controller ([0028], Figure 3) comprising:

a search packet receiver configured to receive, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus, ([0050]; a query reads on the claim limitation "search packet", Figure 5: item 306)

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a response transmitter configured to transmit, to the terminal apparatus, a response to the search packet, ([0050], Figure 5 , item S308)

a receiver configured to receive, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, after the response to the search packet is transmitted to the terminal apparatus, and ([0050], in order to send a reply (S312), it has to know the IP address and therefore must have received it from the service client (SC) due to inherency)

Choi fails to disclose transmit, to the terminal apparatus, the scanned image data, based on the IP address of the terminal apparatus. Matsuura discloses transmit, to the terminal apparatus, the scanned image data, based on the IP address of the terminal apparatus. ([0007]) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to disclose transmit, to the terminal apparatus, the scanned image data, based on the IP address of the terminal apparatus in the disclosure of Choi. The motivation for doing so would have been to allow parallel sending of data to a plurality of computers via a network. ([0006])

As per claims 18 and 22, Choi/ Matsuura disclose the scanner apparatus of claim 17, and Choi fails to disclose transmitting response, and Choi discloses wherein the search packet includes identification information, the identification information identifying the terminal apparatus, and the response transmitter transmits, to the terminal apparatus, the response to the search packet, when the identification

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information of the search packet matches identification information of the scanner apparatus. ([0041], [0050], Figure 3: item 22, Figure 5)

As per claims 28, 30, and 32, Choi/Matsuura disclose the scanner apparatus according to claim 17. Choi discloses wherein the identification information identifying the terminal apparatus comprises a group name of the terminal apparatus, and the response transmitter transmits, to the terminal apparatus, the response to the search packet, when the group name of the search packet matches a group name of the scanner apparatus. ([0033]; group names - host name can either be a default name, which is provided in advance to represent a function of the device, or a name made by a user. Where identical default names exist, extension numbers are added for distinguishing one from another. [0050]; Figure 5: items S308, S312)

As per claims 33-35, Choi / Matsuura disclose the scanner apparatus according to claim 17, and Choi discloses wherein the search packet receiver is configured to receive a search packet that is broadcast by the terminal apparatus. ([0050]; Figure 5: S306)

Claims 19-20 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi (US 2002/0040397) / Matsuura (US 2001/0021945) in view of Idehara et al. – hereinafter Idehara (US 2002/0038372)

As per claims 19 and 23, Choi / Matsuura disclose the scanner apparatus according to claim 17. Choi discloses further comprising a memory configured to store data and an input configured to input information, wherein the terminal information the IP address of the terminal apparatus, the controller stores the IP address of the terminal apparatus in the memory, the controller obtains, from the memory, the IP address of the terminal apparatus. ([0041], Figure 3: item 22)

Choi fails to disclose inputs a password, associating password with ip address, and transmitting to terminal apparatus, the scanned image data , based on obtained IP address. Idehara discloses inputs a password, associating password with ip address, and transmitting to terminal apparatus, the scanned image data , based on obtained IP address. ([0137], [0142], The device information of the scanner 10 contains the connection information required for establishing the connection between the portable terminal 40 and the scanner 10 via the local interface 17 and the network 30, [0154]; Figure 8: item S209, [0285])

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to disclose inputs a password, associating password with ip address, and transmitting to terminal apparatus, the scanned image data , based on obtained IP address. Idehara discloses inputs a password, associating password with ip address, and transmitting to terminal apparatus, the scanned image data , based on obtained IP address in the disclosure of Choi. The motivation for doing do would have to implement the security function. ([0285])

As per claims 20 and 24, Choi/Matsuura disclose the scanner apparatus according to claim 17. These limitation are similar to that of claim 19, however replaces a password with a username. Choi fails to disclose inputs a username, associating a username with IP address, and transmitting to terminal apparatus, the scanned image data, based on obtained IP address. ([0137],[0146]; [0285]; Figure 8: item S209, login name reads on the limitation for a username) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to disclose in the disclosure of Choi. The motivation for doing do would have been to identify the user and to implement the security function. ([0138],[0285])

Claims 27, 29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi (US 2002/0040397) / Matsuura (US 2001/0021945) in view of Day (US 6,052,784)

As per claims 27, 29, and 31, Choi/Matsuura disclose the scanner apparatus according to claim 17, and Choi fails to disclose transmitter does not transmit the response to the search packet when the identification information of the search packet does not match the identification information of the scanner apparatus. Day discloses wherein the response transmitter does not transmit, to the terminal apparatus, the response to the search packet, when the identification information of the search packet does not match identification information of the scanner apparatus. (Col 2 line 40-65, Figure 1A: item 120) At the time the invention was made, it would have been obvious to

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a person of ordinary skill in the art to disclose transmitter does not transmit the response to the search packet when the identification information of the search packet does not match the identification information of the scanner apparatus in the disclosure of Choi. The motivation for doing so would have been to determine if the discovery request data is authentic (Col 2 lines 40-65)

### ***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Toyoda (US 6,880,019) discloses a PC sends a pair of a self-IP address and a mail address to a RARP processing section in response to the RARP request. After obtaining an IP address of this PC, a scanner scans an original, and generates e-mail to which the image is appended. However, it was not used in the rejection, yet listed in the IDS, due to the same assignee as this applicant. A close review of these references is recommended.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chirag R. Patel whose telephone number is (571)272-7966. The examiner can normally be reached on Monday to Friday from 7:30AM to 4:00PM.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).



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